

DOCKET NO.: **OO-0006
Application No.: 09/866,765
Office Action Dated: September 4, 2008

**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

REMARKS

Summary of the Office Action

Claims 44-115 are pending in the present application. Claim 44 is currently amended. No claims are currently added or canceled. Claims 44-115 stand rejected.

Claims 44-48, 51-57, 60-67, 77-82, 84-85, 92-96, 99-106, and 108-109 stand rejected under 35 USC § 102(b) as being anticipated by Broadwin, US Patent 5,903,816 (“Broadwin”).

Claims 49, 58, 68, 83, 97, 107 stand rejected under 35 USC § 103(a) as being unpatentable over Broadwin in view of Yeo, US Patent 6,219,837 (“Yeo”).

Claims 50, 59, 71, 86, 98, and 110 stand rejected under 35 USC § 103(a) as being unpatentable over Broadwin in view of Yeo, further in view of Fernandez, US Patent 6,339,842 (“Fernandez”).

Claims 72, 87, and 111 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Herrington, US Patent 6,922,843 (“Herrington”).

Claims 73, 88, and 112 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Keren, US Publication 2001/0024469 (“Keren”).

Claims 74-75, 98-90, and 113-114 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Ramsey Catan, US Publication 2002/0073416 (“Ramsey Catan”).

Claims 76, 91, and 115 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Ramsey Catan, further in view of Malec, US Patent 5,490,060 (“Malec”).

The claim rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections in view of the above amendment and the following remarks. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants’ undersigned agent, Jon M. Isaacson, at **206-332-1102**.

Telephonic Interview

On November 3, 2008, Examiner Smith, Mr. Grant, and applicants representatives Jon M. Isaacson and Michael D. Stein conducted a telephonic interview. Applicants' representatives would like to thank Examiner Smith and Mr. Grant for granting the interview. During the interview, the cited portions of Broadwin were discussed, particularly the portions that discuss an audio-video-interactive (AVI) signal.

Claim rejections under 35 USC § 102

Claims 44-48, 51-57, 60-67, 77-82, 84-85, 92-96, 99-106, and 108-109 stand rejected under 35 USC § 102(b) as being anticipated by Broadwin.

Claim 44 recites, in part, "wherein...the instructions for the set-top box *configure the set-top box to display the first content if the interactive icon is selected*" (emphasis added) and recites "transmitting the broadcast signal to the set-top box" where the instructions are included in the broadcast signal. Applicants respectfully submit that this recitation of claim 44 is not taught by the cited portions of Broadwin. The examiner cites to Broadwin, col. 7, lines 48-53, as disclosing this recitation. That portion of Broadwin states:

For example, the user or viewer may choose a selection or button displayed on the screen to view a linked still image according to the present invention. The user or viewer may also choose a selection or button to order a product or order information, provide answers to a television game show, etc.

While this citation discloses responses to user selections, it does not disclose how the instructions corresponding to user selections are received. Looking at the portion of Broadwin that immediately follows, Broadwin teaches that "interactive decoder 140 also includes a modem 324 which is provides information on the return channel 156 for user interactivity." (Col. 7, lines 54-56; see also Figs. 2 and 3.) The modem is configured for bi-directional communication and the return channel can be connected to a transaction server for processing order information or to a media server which provides additional MPEG still images for display. (Col. 7, line 59 – Col. 8, line 2.) Because the modem and return channel are configured to provide communication to and from a backend server, it is possible for Broadwin to transmit instructions via the return channel to the interactive decoder. Thus, in addition to the cited portion of Broadwin being silent on how the instructions corresponding

to user selections are received, Broadwin also provides a connection to a backend server which allows for the instructions to be sent outside of the video programming transmission. Therefore, applicants submit that the cited portions of Broadwin fails to disclose “transmitting the broadcast signal to the set-top box” where the broadcast signal includes “instructions for the set-top box *configure the set-top box to display the first content if the interactive icon is selected*” (emphasis added), as recited by claim 44. Applicants respectfully request withdrawal of the rejection of claim 44.

Independent claims 53, 62, 77, 92, and 101 all stand rejected under 35 USC § 102(b) as being anticipated by Broadwin. For at least the reasons discuss above regarding claim 44, applicants submit that claims 53, 62, 77, 92, and 101 are patentably defined over Broadview. Applicants respectfully request withdrawal of the rejection of claims 53, 62, 77, 92, and 101.

Claims 45-48 and 51-52 depend from claim 44; **claims 54-57 and 60-61** depend from claim 53; **claims 63-67** depend from claim; **claims 78-82 and 84-85** depend from claim 77; **claims 93-96 and 99-100** depend from claim 92; and **claims 102-106 and 108-109** depend from claim 101. Each of these dependent claims stands rejected under 35 USC § 102(b) as being anticipated by Broadwin. For at least the reasons discuss above regarding claim 44, applicants submit that claims 53, 62, 77, 92, and 101 are patentably defined over Broadview. Applicants respectfully request withdrawal of the rejection of claims 53, 62, 77, 92, and 101. Additional arguments are given below for the allowability for some of these dependent claims.

Applicants submit that **claim 48**, in addition to the reasons discussed above, is patentably defined over Broadwin because Broadwin fails to teach or suggest a first file with first content, “wherein the first content includes a purchasing screen for purchasing the product on at least a portion of the second content in the video signal” as recited by claim 48. According to Broadwin, a user “may choose a selection or button displayed on the screen to view a linked still image []. The user or viewer may also choose a selection or button to order a product.” (Broadwin at col. 7, lines 48-52). Applicants respectfully submit that Broadwin states that the purchasing screen is a linked still image loaded from a different channel, see, e.g., Broadwin at col. 6, line 26-27 and Broadwin at col. 6, lines 34-35 stating “MPEG stills are transmitted on the one or more still image channels” and “selections may

reference other MPEG stills, or may be used to order information or products.” However, Broadwin fails to disclose “a purchasing screen for purchasing *the product* on at least a portion of the *second content in the video signal*.” (Emphasis added.) Accordingly, for at least this additional reason Applicants respectfully request reconsideration of the rejection of claim 48.

Inasmuch as dependent **claims 57, 66-67, 81-82, 96, and 105-106** recite elements similar to claim 48, they too patentably define over Broadwin for at least the same reasons as claim 48. Accordingly, for at least this additional reason Applicants respectfully request withdrawal of the rejection of claims 57, 66-67, 81-82, 96, and 105-106.

Claim rejections under 35 USC § 103(a)

Claims 49, 58, 68, 83, 97, 107 stand rejected under 35 USC § 103(a) as being unpatentable over Broadwin in view of Yeo. For at least the reasons discussed above regarding independent claims 44, 53, 62, 77, 92, and 101 as being patentably defined over Broadwin, applicants submit that claims 49, 58, 68, 83, 97, 107 are patentably defined over Broadwin in view of Yeo. Applicants respectfully request withdrawal of the rejection of claims 49, 58, 68, 83, 97, 107.

Claims 50, 59, 71, 86, 98, and 110 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Yeo, further in view of Fernandez. For at least the reasons discussed above regarding independent claims 44, 53, 62, 77, 92, and 101 as being patentably defined over Broadwin, applicants submit that claims 50, 59, 71, 86, 98, and 110 are patentably defined over Broadwin in view of Yeo, further in view of Fernandez. Applicants respectfully request withdrawal of the rejection of claims 50, 59, 71, 86, 98, and 110.

Further concerning **claim 50**, Applicants submit that Fernandez teaches a data source that provides “two-way or interactive access to one or more database, file, directory, or other functionally equivalent data repository site or signal source, accessible or addressable publicly or privately over *conventional network* 10 such as ... world-wide web... connection equipment for enabling ... TCP/IP.” (Fernandez at col. 2 lines 5-10). Applicants submit that Fernandez teaches sending information about current events over a TCP/IP network

connection, not over a broadcast signal. Applicants respectfully submit that the reason provided by the Examiner is insufficient because it fails to address why one of skill in the art would modify a teaching of sending current events via a TCP/IP network connection to arrive at the subject matter of the claim. Applicants respectfully submit that the Examiner has not performed a proper obviousness analysis but rather relies on improper hindsight to select disparate aspects of the prior art and assemble them in the manner recited by Applicants' claims. Accordingly for at least this additional reason Applicants respectfully requests withdrawal of the rejection of claim 50.

Inasmuch as **claims 59, 71, 86, 98, and 110** recite elements similar to claim 50, they too patentably define over Broadview in view of Yeo, further in view of Fernandez for at least the same reasons as claim 50. Accordingly, for at least this additional reason Applicants respectfully request withdrawal of the rejection of claims 59, 71, 86, 98, and 110.

Claims 72, 87, and 111 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Herrington. For at least the reasons discussed above regarding independent claims 44, 53, 62, 77, 92, and 101 as being patentably defined over Broadwin, applicants submit that claims 72, 87, and 111 are patentably defined over Broadwin in view of Herrington. Applicants respectfully request withdrawal of the rejection of claims 72, 87, and 111.

Claims 73, 88, and 112 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Keren. For at least the reasons discussed above regarding independent claims 44, 53, 62, 77, 92, and 101 as being patentably defined over Broadwin, applicants submit that claims 73, 88, and 112 are patentably defined over Broadwin in view of Keren. Applicants respectfully request withdrawal of the rejection of claims 73, 88, and 112.

Claims 74-75, 98-90, and 113-114 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Ramsey Catan. For at least the reasons discussed above regarding independent claims 44, 53, 62, 77, 92, and 101 as being patentably defined over Broadwin, applicants submit that claims 74-75, 98-90, and 113-114 are patentably

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Claims 76, 91, and 115 stand rejected under 35 USC § 103(a) as being unpatentable over Broadview in view of Ramsey Catan, further in view of Malec. For at least the reasons discussed above regarding independent claims 44, 53, 62, 77, 92, and 101 as being patentably defined over Broadwin, applicants submit that claims 76, 91, and 115 are patentably defined over Broadwin in view of Keren. Applicants respectfully request withdrawal of the rejection of claims 76, 91, and 115.

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the official action, and submit that claims 44-115 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

Date: December 4, 2008

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